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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

SHAH, AMEE A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 05/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/083,432	Applicant(s) HYPPA ET AL.	
	Examiner Amea A. Shah	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) 22-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>Feb. 26, 2002</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-25 are pending in this instant action.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21 and 25, drawn to a method and apparatus claim relating to generating a data entity, including information of an object, transmitting the data entity and requests by the user equipment for additional information, classified in class 705, subclass 26.
- II. Claims 22-24, drawn to a system claim directed to processing a transaction between the user equipment and third party, classified in class 705, subclass 26.

Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In the instant case, invention II as claimed can be used to practice the process of processing a transaction between the user equipment and third party, not required by invention I.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art because of their recognized divergent subject matter, and the search required for invention II is not required for invention I, restriction for examination purposes as indicated is proper.

During a telephone conversation with Robert Kelly, Esq. on April 18, 2005, a provisional election was made without traverse to prosecute the invention of group I, claims 1-21 and 25. Affirmation of this election must be made by applicant in replying to this Office action. Claims 22-24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

The drawings are objected to because Figure 3, which is a flow chart, is not sufficiently referenced in the specification and should contain reference numbers for each step. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: "25." Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended

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drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The disclosure is objected to because of the following informality: “ULR,” referring to a universal resource locator, used on pages 10, 11 and 13 appears to a typographical error and should likely read --URL--. Appropriate correction is required.

The use of the trademarks “VCARD,” “VCAL” and “I-PHONE” has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Objections

Claims 1, 8 and 14 are objected to because of the following informalities: (1) Claim 1 states that the system comprises of, in part, "requesting by the user equipment for additional information..." (page 10, lines 12-13) and should read -- requesting of additional information by the user equipment -- or -- the user equipment requesting additional information...--; (2) Claim 8 states "by the producer the subject" (page 20, line 7) and should read --by the producer of the subject--; (3) Claim 14 states "the user may request for additional information" and should read -the user may make a request for additional information-- or --the user may request additional information--. Appropriate corrections are required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 25 is an apparatus claim using “means plus function” language. The examiner could not find corresponding structure of a means-plus-function limitation for “receiving a data entity” and for “processing the received data entity” in the specification itself in a way that one skilled in the art will understand what structure will perform the recited function. Therefore, claim 25 is rendered unclear. *See* MPEP §2181.

In view of the above, the examiner will not invoke 35 USC 112, 6th paragraph, while examining claim 25, and will give it the broadest reasonable interpretation.

Claim Rejections - 35 USC § 102

I. The following is a quotation of 35 U.S.C. 102(b) that forms the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 15-17, 20, 21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Vazvan (WO 97/45814), cited in IDS filed February 26, 2002.

Referring to claim 1. Vazvan discloses a method in a system wherein a user equipment and another party are enabled to exchange transaction data (Vazvan, page 3, lines 3-25 – note that the user equipment is a SIM-operated portable terminal, that another party is a service

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provider terminal or host computer, and that the transaction data is the data associated with the payment transaction and transfer of money), the method comprising:

- generating a data entity that associates with a transaction (Vazvan, page 3, lines 3-8 – note that the data entity is the user's details);
- including information of an object that associates with the transaction in the data entity (Vazvan, page 3, lines 3-8 – note that the information of an object is account number, contact code, address, etc.);
- transmitting the data entity to the user equipment over a wireless interface (Vazvan, page 3, lines 3-8); and
- requesting of additional information by the user equipment that associates with the transaction based on said information of the object (Vazvan, page 3, lines 19-25, and col. 11, lines 15-18 – note that the requesting of additional information is the user sending a message and requesting a bill).

Referring to claim 15. Vazvan further discloses the method as claimed in claim 1, wherein the data entity is for provision of a receipt (Vazvan, page 3, lines 3-25 – note that the provision of a receipt is the bill).

Referring to claim 16. Vazvan further discloses the method as claimed in claim 1, wherein the data entity is for provision of an offer (Vazvan, page 6, lines 23-33 – note that the provision of an offer is the bill format, etc. needed to perform the purchase).

Referring to claim 17. Vazvan further discloses the method as claimed in claim 1, wherein the data entity is for provision of conditions for sale (Vazvan, page 6, lines 23-33 – note that the provision of conditions for sale is the bill format, etc. needed to perform the purchase).

Referring to claim 20. Vazvan further discloses the method as claimed in claim 1, wherein the user equipment communicates via a local wireless link with another station (Vazvan, page 3, lines 13-16 and page 8, lines 30-41 – note that the other station is the petrol station's terminal).

Referring to claim 21. Vazvan further discloses the method as claimed in claim 1, wherein the user equipment communicates via at least two different communication means (Vazvan, page 6, lines 12-20 and page 12, lines 24-25 – note that the two different communication means are a telephone mode and a wireless network).

Referring to claim 25. Vazvan discloses a mobile user equipment adapted for processing electronic transactions (Vazvan, figure 9, and page 10, line 33 through page 12, line 35), comprising:

- receiver means for receiving a data entity from a remote unit, said data entity including transaction data and information of an object associated with the transaction (Vazvan, figure 9, and page 10, line 34); and
- control means for processing the received data entity, said control means being adapted to request for additional information based on said information of the

object (Vazvan, figure 9, and page 11, lines 5-24 – note that the control means for processing comprises the MWP and messaging capabilities).

II. The following is a quotation of 35 U.S.C. 102(e) that forms the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 13 and 14 are rejected under 35 U.S.C. 102(e)(1) as being anticipated by Yu (Pub. No. US 2002/0007319 A1).

Referring to claim 1. Yu discloses a method in a system wherein a user equipment and another party are enabled to exchange transaction data (Yu, page 1, ¶0014 – note that the user equipment is a computer, that another party is a shopping website, and that the transaction data is the data associated with shopping at the website), the method comprising:

- generating a data entity that associates with a transaction (Yu, page 1, ¶0015 – note that the data entity is the shopping path);
- including information of an object that associates with the transaction in the data entity (Yu, page 1, ¶¶0016-0022 – note that the information of an object is the transaction-occurred shopping web page);

- transmitting the data entity to the user equipment over a wireless interface (Yu, page 1, ¶0014 – note that the wireless interface is an inherent capability of a mobile phone with browsing functionality); and
- requesting of additional information by the user equipment that associates with the transaction based on said information of the object (Yu, page 1, ¶0020 – note that the requesting of additional information is the request from the consumer to return back to a prior web page).

Referring to claim 2. Yu further discloses the method as claimed in claim 1, wherein the information of the object comprises a communication network address of the object (Yu, page 1, ¶0017 – note that the communication network address of the object is the URL of the transaction occurred shopping web page).

Referring to claim 3. Yu further discloses the method as claimed in claim 1, wherein the information of the object comprises a universal resource locator (URL) (Yu, page 1, ¶0017).

Referring to claim 4. Yu further discloses the method as claimed in claim 1, wherein the object comprises a storage means for storing information that associates with the subject of the transaction (Yu, page 1, ¶0018 – note that the storage means is the database which stored the shopping path).

Referring to claim 5. Yu further discloses the method as claimed in claim 1, wherein the user equipment initiates procedure for establishment of a communication media between the user equipment and the object based on said information of the object (Yu, page 1, ¶0016 – note that the user equipment initiating procedure is the process of the consumer logging into the shopping website and purchasing items on the shopping website).

Referring to claim 13. Yu further discloses the method as claimed in claim 1, wherein an indicator is displayed to the user of the user equipment based on said information of the object (Yu, figure 3, and page 1, ¶0019 – note that the indicator is a shopping path record list).

Referring to claim 14. Yu further discloses the method as claimed in claim 13, wherein the user may request additional information by selecting the displayed indicator (Yu, figure 3, and page 1, ¶¶0019-0021 – note that the selection of the displayed indicator is the user enables to chooses a recorded item and linking back to the recorded shopping page).

Claims 1, 7-10 and 19 are rejected under 35 U.S.C. 102(e)(2) as being anticipated by Venigalla (US Pat. No. 6,766,361 B1).

Referring to claim 1. Venigalla discloses a method in a system wherein a user equipment and another party are enabled to exchange transaction data (Venigalla, col. 2, lines 52-61 – note that the user equipment is a computer-based visitor machine, that another party is a computer-

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based host machine, and that the transaction data is the electronic commerce transaction data), the method comprising:

- generating a data entity that associates with a transaction (Venigalla, col. 7, lines 46-53 – note that the data entity is an interface request);
- including information of an object that associates with the transaction in the data entity (Venigalla, col. 8, lines 5-16 – note that the object can be a URL or product);
- transmitting the data entity to the user equipment over a wireless interface (Venigalla, col. 4, lines 35-42); and
- requesting of additional information by the user equipment that associates with the transaction based on said information of the object (Venigalla, col. 8, lines 54-58, and col. 11, lines 15-18 – note that the requesting of additional information is the visitor replying with further inquiry and querying the host for information).

Referring to claim 7. Venigalla further discloses the method as claimed in claim 1, wherein the object comprises a site in a data network (Venigalla, col. 8, lines 5-16 – note that the site in a data network is the URL).

Referring to claim 8. Venigalla further discloses the method as claimed in claim 7, wherein the site comprises a document that is retrievable from a server, said server being run by the producer of the subject of the transaction (Venigalla, col. 7, lines 54-65 – note that the document is the server responses in XML-based ASCII text format).

Referring to claim 9. Venigalla further discloses the method as claimed in claim 1, wherein the additional information relates with at least one characteristic of the subject of the transaction (Venigalla, col. 11, lines 15-18 – note that the additional information relating to at least one characteristic is a product code).

Referring to claim 10. Venigalla further discloses the method as claimed in claim 9, wherein the at least one characteristic relates to a specific product or service (Venigalla, col. 11, lines 15-18 – note that the one characteristic is a product code, inherently relating to a specific product or service).

Referring to claim 19. Venigalla further discloses the method as claimed in claim 1, wherein the user equipment communicates with an element of a mobile communication network (Venigalla, col. 4, lines 35-42 – note that the element of a mobile communication network is the wireless communication technology associated with a cellular phone).

Claims 1, 6, 11 and 12 are rejected under 35 U.S.C. 102(e)(2) as being anticipated by Nel (US Pat. No. 6,363,364 B1).

Referring to claim 1. Nel discloses a method in a system wherein a user equipment and another party are enabled to exchange transaction data (Nel, col. 4, lines 24-55 – note that the user equipment is a user base comprising a television set, decoder, and keypad, that another party

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is a computer network of a financial institution, and that the transaction data is the data relating to financial transactions), the method comprising:

- generating a data entity that associates with a transaction (Nel, col. 4, lines 39-55 – note that the data entity is the user request);
- including information of an object that associates with the transaction in the data entity (Nel, col. 4, lines 39-55 – note that the object is an account);
- transmitting the data entity to the user equipment over a wireless interface (Nel, col. 4, lines 39-44) – note that the wireless interface is via antenna and satellite); and
- requesting of additional information by the user equipment that associates with the transaction based on said information of the object (Nel, col. 4, lines 45-55 – note that the requesting of additional information is considered to be inherent in the claim that multiple transactions can be performed).

Referring to claim 6. Nel further discloses the method as claimed in claim 1, wherein the object is controlled by a third party (Nel, col. 4, lines 45-67 – note that the third party is a second institution).

Referring to claim 11. Nel further discloses the method as claimed in claim 1, wherein the additional information is provided by communication comprising speech (Nel, col. 5, lines 10-18 – note that the communication comprising speech is the communication from a phone to an interactive voice response system).

Referring to claim 12. Nel further discloses the method as claimed in claim 11, wherein the user of the user equipment establishes a communication media with a person based on said information of the object (Nel, col. 5, lines 10-18 – note that the communication media is through the interactive voice response system).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Vazvan in view of Chan (Pat. No. 6,254,001 B1).

Referring to claim 18. Vazvan discloses the method as claimed in claim 1, discussed supra, with the exception of wherein the data entity is based on an electronic data card format. Chan discloses that electronic data cards can be transferred via wireless or wired means (Chan, col. 1, lines 39-46). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have modified the systems of Vazvan to include the teachings of Chan

to allow for the electronic transfer of data based on an electronic card format. Doing so would allow for a user to save paper resources and user time (Chan, page 1, lines 25-33).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(1) Lichstein, EO 0 971 327 A2, cited in IDS filed February 26, 2002, disclosing a method and system for providing financial services such as home banking and can be used to reject claims 1-4, 6-10, 13, 14, and 19; (2) Kolls, US Patent No. 6,856,820 B1, disclosing an in-vehicle device for wirelessly connecting a vehicle to the internet and for transacting e-commerce and e-business; (3) Gershman et al., US Patent No. 6,356,905 B1, disclosing a system, method and article of manufacture for mobile communication utilizing an interface support framework; (4) Griffin et al., Pub. No. US 2002/0049636 A1, disclosing a system and method for generating and transmitting data keys to facilitate delivery, pick-up and other commercial transactions; (5) Lipton et al., WO 00/31699, cited in IDS filed February 26, 2002, disclosing a method of and apparatus for conducting electronic transactions; (6) Ellison et al., GB 2344491A, cited in IDS filed February 26, 2002, disclosing a system for browsing the internet using a mobile telephone; and (7) PalmOne™ Press Release, Palm Sets The Pace With Enhanced Wireless Palm VIIx Handheld, Aug, 7, 2000, <http://www.palmone.com/us/company/pr/2000/080700c.html>.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAS

4/21/05


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